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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,600	04/09/2001	Steven E. Barile	42390P9913	7945

7590 08/29/2003

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EXAMINER	
ALAUBAIDI, HAYTHIM J	
ART UNIT	PAPER NUMBER
2171	#6

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/829,600	Applicant(s) BARILE ET AL.	
	Examiner Haythim J. Alaubaidi	Art Unit 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This communication is in response to the amendment filed on Jun 16, 2003.

2. Claims 1-28, are currently presented for examination following the amendment.

3. The Examiner acknowledges the two newly added Claims (Claim 27 and 28).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-5, 7-19 and 21-25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Harry W. Morris (U.S. Patent No. 6,496,851 and Morris hereinafter).

Regarding Claims 1-2, 8-9, 15-16 and 21-22 Morris discloses"

receiving a dedication[1] from a first user (Figure No. 3, Element No. 301; see also Col 3, Lines 47-50, i.e. *A protocol, referred to as the "Rendezvous" protocol, is designed to facilitate interactions between users of a computer network by transmitting a first user's proposal for an activity to another user*; see also Col 8, Line 18)

Morris reference discloses the claimed subject matter set forth above, except it does not explicitly indicate the applying of the dedication to a play list of a second user feature. However the reference does teach applying instant messages to an applet that

could be considered as a play list[2] (Figure No. 2[3]; see also Figure NO's 10 and 11; see also Col 5, Lines 58-59, i.e. *send IMs back and forth, and transfer files*). Given the intended broad application of the Morris system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Morris by using the chat rooms as play lists, one way to do this is through the use of audio or voice in the chat room (play list) as it was indicated by Morris (Col 4, Lines 24-25); another reason why a "play list" could be interpreted as an applet of a chat room is due to the capability of playing games through these chat rooms (play list), see Col 4, Line 25, i.e. play an online game; another reason would be by interpreting the "file transfer capability" mentioned in Morris Col 4, Line26 to actually us an audio or video file (like it is mentioned in the instant application in Claim 3 and 4).

Regarding Claims 3-4, Morris discloses audio and/or video (Col 9, Lines 58-64).

Regarding Claims 5, Morris discloses text messages (Figure No. 11).

Regarding Claims 7, Morris discloses wherein the first and second users are online (Col 5, Lines 17-23).

Regarding Claims 27 and 28, the Applicant admits that wherein the play list comprises at least one identifier of a media file to be rendered by a media player application (Specification Page 2, Line 30 through Page 3, Line 5).

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[1] The "dedication" is being interpreted to be for example like a request to chat with a second user or a request to transfer a file to a second user or even a request to play a game with a second user.
[2] The "play list" in the instant application can be interpreted to be the applet where the users are chatting or even playing a game (see Figure No. 2), please see Col 4, Lines 24-28, i.e. *Typical activities include exchanging voice messages, playing an online game, finding a route from one client computer to another, transferring files, direct instant messaging, exchanging avatars, participating in a chat room, or engaging in collaborative project development.*

6. Claims 6, 20 and 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Harry W. Morris (U.S. Patent No. 6,496,851 and Morris hereinafter) in view of Stephen Sutton (U.S. Patent No. 6,539,354 and Sutton hereinafter).

Regarding Claims 6, 20 and 26, Morris reference discloses the claimed subject matter set forth above, except it does not explicitly indicate the step of converting text to audio. However Sutton discloses converting text to audio (Col 3, Lines 34-35, i.e. *the text-only input is converted into a synthesized audio and visual speech output)*[4]. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Morris with the teachings of Sutton to include such a well known software in order to increase the flexibility of the system and also to make it more user friendly; another reason would be to increase the amount of users who can actually make use of the system, such as the visually challenged people.

Response to Arguments

7. Applicant's arguments filed in the amendment of Jun 16, 2003 have been fully considered but they are not persuasive.

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[3] The Element No. 204 is showing different users chatting with each other, which in other words, the system is applying the chat message or the text or the voice or even a transfer file (dedicating) to the applet (play list).

[4] The Examiner would like to direct the Applicant's attention to the fact that this converting feature is well know in the art, including the Patent No. 6,448,485 awarded to the same inventor and the same assignee of the current Application.

Applicant argues that Morris does not teach, "receiving a dedication". The Examiner respectfully disagrees. Other then what was cited by the Examiner in the first Action (Figure No. 3, Element No. 301; see also Col 3, Lines 47-50, i.e. *A protocol, referred to as the "Rendezvous" protocol, is designed to facilitate interactions between users of a computer network by transmitting a first user's proposal for an activity to another user*; see also Col 8, Line 18), it is also known to millions of users and those who are skilled in the art, that it is very common for a first user to send an e-mail to a second user with an attachment of a URL (that could be a link to a website that advertise videos or songs) or an attachment of the song or the video it self, or an attachment of a document (that could contain text) through the network, whether the applicant like to call the above method a " dedication" or simply sending an e-mail, the claim language as it is currently with the two limitations would not bring the Claim to the level of patentability.

Applicant also argues that Morris does not teach, "play list". The Examiner respectfully disagrees. Other then what was cited by the Examiner in the first Action (Figure No. 2^{5}; see also Figure NO. 10 and 11; see also Col 5, Lines 58-59, i.e. *send IMs back and forth, and transfer files*), The Examiner might agree to a certain point that in the search of the prior art, non of the references were very clear in describing the method of sending a dedication of a media, such as a song or a video to a second user who in turn can apply and/or add this media file to a play list, that the perception of the dedication by the second user will occur in the context of an internet radio application using a browser, or during the playing of media files by a media player application, as described

in the Specification and by the amendment of Jun 16, 2003. Yet at the same time, the Applicant also didn't claim the above mentioned description, in fact the claimed limitations of the independent Claims are so broad, it can actually read on any e-mail being sent from one user to another that contains an attachment. A "play list" can be interpreted to many things other than what's in the Specification...but what is in the Claims language is the part that being examined.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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[5] The Element No. 204 is showing different users chatting with each other, which in other words, the

Points of Contact

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6th Floor Receptionist, Arlington, Virginia. 22202.

Haythim J. Alaubaidi

Haythim J. Alaubaidi
Patent Examiner
Technology Center 2100
August 24, 2003

SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
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system is applying the chat message or the text or the voice or even a transfer file (dedicating) to the applet (play list).